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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,689	10/17/2003	Toshiyuki Matsumura	KON-1831	9334

20311 7590 03/02/2006

LUCAS & MERCANTI, LLP  
475 PARK AVENUE SOUTH  
15TH FLOOR  
NEW YORK, NY 10016

EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,689

Applicant(s)

MATSUMURA ET AL.

Examiner

Barbara L. Gilliam

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 6-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed November 8, 2005 has been entered and fully considered.
2. Claims 1, 3-4, 6-23 are pending of which 21-23 are new. New claims 21-23 are fully supported and do not introduce new matter.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4, 6, 9, 15-17, 19-20, 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/828,081 (US 2004/0219459 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the method for producing a photosensitive planographic printing plate claimed

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by Hirabayashi produces a printing plate comprising a photosensitive composition containing a monomer of General Formula (1) or General Formula (2) having an ethylenic double bond, a polymeric binder and a photoinitiator composition containing an iron arene complex and a polyhalogen compound such as the compounds represented by General Formulae (3)-(5) (claims 1-4). The monomers represented by General formula (1) and General formula (2) meet the present limitations for the ethylenically unsaturated monomer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1, 3, 7, 9-12, 15, 17-18, 21, 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8-11 and 15 of copending Application No. 10/923,415 (US 2005/0048403 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to make a planographic printing plate comprising a hydrophilic support, a light sensitive layer and an overcoat layer wherein the light sensitive layer contains an alkali soluble polymer, a polymerizable compound having an ethylenically unsaturated bond, a polymerization initiator and an anionic dye (claims 1, 8) wherein the polymerization initiator comprises a metallocene compound and a polyhalogenated compound (claims 2-4, 9-11) based on the claims of Kuroki.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 3, 7-15, 17-18, 21-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6-8, 10-13, 16-18 of copending Application No. 10/769,389 (US 2004/0191691 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make a light sensitive composition comprising an addition polymerizable ethylenically unsaturated monomer, a trihalomethyl group-containing oxadiazole compound represented by formula (1) or (2) as a photopolymerization initiator and a polymer binder (claims 1-3, 10-13). The composition can further contain a titanocene compound, a monoalkyltriaryl-borate compound and an iron-arene compound (claims 4-6, 14-16) and a dye having an absorption maximum in the wavelength regions of from 350 to 1200 nm (claims 7-8, 17-18) based on the claims of Ohta et al.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 3, 9-11, 14-15, 17-18, 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-7 of copending Application No. 10/770365. Although the conflicting claims are not identical, they are not patentably distinct from each other because Kuroki et al. claim a photosensitive composition comprising a polymerizable compound having an ethylenically unsaturated group, a metallic arene compound and an acid generating

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agent represented by formulae (1), (3) or (4). The acid-generating agent meets the present limitations for the compound of formula (1-b). The composition further contains a dye (claim 10).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 3, 8-11, 13-15, 17-18, 22-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/758766 (2004/0157153 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because Takamuki claim a method of forming a light sensitive planographic printing plate wherein the printing plate comprises a light sensitive layer containing an addition polymerizable ethylenically unsaturated monomer, a polymerization initiator a polymer binder and a sensitizing dye having an absorption maximum in the wavelength regions of from 390 to 430 nm (claims 1, 8). The polymerization initiator can be a monoalkyltriarylborate compound, an iron arene complex, a bromine containing compound (claims 3-6). It would have been obvious to one of ordinary skill in the art to use a combination of photopolymerization initiators based on the overall teaching of Takamuki ([0035]-[0041]).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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9. Claims 1, 3, 7, 9, 15, 17-18, 21, 23-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 8-11 of copending Application No. 11/047765 (2005/0233248 A1) in view of Aoshima et al. (US 2002/0160295 A1). The conflicting claims are not identical, they are not patentably distinct from each other because the planographic printing plate of the copending Application comprises a support and an image forming layer wherein the image forming layer contains a colorant having an absorption band in a wavelength region of from 700 to 1200 nm, a polymerization initiator of Formula (1) and a polymerizable ethylenically unsaturated compound. The polymerization initiator of Formula (1) is very similar to the present polymerization initiator of Formula (1-b). Compounds fulfilling Formula (1) of the corresponding application also fulfill the present formula requirements. The image forming layer can further contain a titanocene compound and/or an iron-arene compound (claim 8). The copending Application does not claim a binder in the image forming layer however it would have been obvious to one of ordinary skill in the art to incorporate a polymeric binder based on the teachings of Aoshima et al. ([0038]-[0040]).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1, 3, 7, 9, 15, 17-18, 21, 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6-7 of copending Application No. 10/896206 (2005/0053866 A1) in view of Aoshima et al. (US 2002/0160295 A1). Although the conflicting claims are not identical, they are

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not patentably distinct from each other because Matsumura claim a planographic printing plate material comprising a support and an image formation layer containing a colorant, a polymerization initiator of formula (1) and a polymerizable ethylenically unsaturated compound. When R<sub>1</sub> and X are bromine atoms, the compound of formula (1) meets the present limitations for compound (1-b). The image formation layer further comprises an iron-arene compound and/or a titanocene compound. The copending Application does not claim a binder in the image forming layer however it would have been obvious to one of ordinary skill in the art to incorporate a polymeric binder based on the teachings of Aoshima et al. ([0038]-[0040]).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

11. Applicant's arguments in light of the claim amendments, filed November 8, 2005, with respect to the rejection of claims 1, 3, 17 and 18 under 35 USC 102(b) over Purbrick (EP 29358) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the copending Applications cited above.

12. The indicated allowability of claims 4, 6-16, 19 and 20 is withdrawn in view of the newly discovered references to the copending Applications cited above. Obviousness-type double patenting rejections based on the newly cited referenced are above.



### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In US 2005/0037286 A1, Hirabayashi et al. teach a similar light sensitive composition

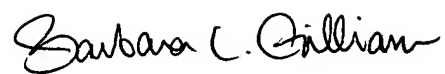
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, reading "Barbara L. Gilliam". The signature is written in a cursive style with a large, stylized 'B' and 'G'.

Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
February 27, 2006